

Application No. 09/857,257
Reply to Office Action of May 18, 2006

REMARKS

Presently, claims 1-9 and 47-80 are pending in the application. A Request for Continued Examination under 37 CFR §1.114 is being submitted herewith. Claims 1 and 5 have been amended. New claims 47-80 have been added. Support for the amendments to independent claims 1 and 5 and the features of new claims 47-80 may be found, for example, on page 4, lines 16-18, page 5, lines 3-9, and page 16, lines 17-19 of the specification. Accordingly, no new matter has been added by the foregoing amendments.

Examiner Interview

Applicants and the undersigned thank Examiner Tri V. Nguyen for the courtesies extended during a telephone interview conducted on June 18, 2006, to discuss the present application and Office Action. During the interview, the Examiner's reading of the prior art and its applicability to the claims of the present application were discussed. Further, potential claim amendments were discussed, and the Examiner acknowledged that those amendments would likely overcome the prior art of record. The Examiner reserved the right to fully consider the amendments upon submission of a formal response.

Information Disclosure Statement

Applicants note that the Examiner has not acknowledged the Information Disclosure Statements filed in the present application on July 26, 2004 and August 11, 2004.

Applicants respectfully request that the Examiner forward an initialed copy of the above-identified Information Disclosure Statements, showing consideration of all the references listed therein, with the next Office Action.

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Claim Rejection – § 102(e)

The Examiner has rejected claims 1, 5, 9-11, 14, 17-19, 23, 25, 27-30, 32-34, 41-43, and 46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,987 to Roth et al. ("Roth"). Applicant respectfully traverses this rejection.

Roth teaches a system for providing advertisements from a central server to viewers who access web sites. Roth's system includes a web server system that has databases stored therein, bidding agents that compare the characteristics of viewing opportunities to the specifications in proposed bids and that submit bids as appropriate, and bid selection logic that determines which proposed bid to accept for each particular viewing opportunity (or "view-op"). In Roth, each advertiser provides one or more "proposed bids" that specify a bid amount for an advertisement with certain characteristics. Each proposed bid is dependent upon or requires the satisfaction of various criteria that must be met in order for a bid of a particular amount to be submitted. In Roth, when a view-op arises, the bidding agents evaluate the characteristics of the view-op compared to the specifications in proposed bids, and the bidding agents submit bids to the bid selection logic if the specifications' requirements are satisfied. Bidding agents perform a Boolean comparison of the criteria to the view-op and if they match (i.e., a "yes" result) a bid is submitted; if not, (i.e., a "no" result) no bid is submitted. The bid logic then selects the highest bid from the various available bids, and the advertisement specified in the highest bid payment offer is displayed.

For a rejection under § 102(e) to be proper, a reference must disclose, either explicitly or inherently, each and every element of the claimed invention. Applicant respectfully submits that Roth does not teach each and every element recited in independent claim 1.

Independent claim 1 recites:

In a networked environment having a plurality of computer systems interconnected for the purpose of instantaneously transmitting and receiving data, a method for auctioning an

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advertisement opportunity, said method comprising the steps of:

- (a) providing notification of an advertisement opportunity from a content/opportunity provider computer system, wherein said advertisement opportunity corresponds to an opportunity to transmit an advertisement to a consumer;
- (b) receiving an advertisement characterization from an advertiser computer system, wherein said advertisement characterization corresponds to an advertisement;
- (c) calculating a correlation factor between said advertisement characterization and said consumer in a profiler computer system;
- (d) transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system; and
- (e) receiving a successful bid for said advertisement opportunity at said content/opportunity provider computer system, wherein said successful bid results in the transmission of said advertisement to said consumer in said advertisement opportunity. (emphasis added)

Roth does not disclose “calculating a correlation factor between said advertisement characterization and said consumer in a profiler computer system.” The Examiner argues that Roth’s Boolean, yes or no analysis is equivalent to a “correlation factor.” Roth’s system merely checks that a pre-determined list of criteria is satisfied and returns a Boolean result. However, a Boolean yes/no result, including that utilized in Roth, does not provide a correlation factor, in that a correlation factor provides more information than a Boolean result.

Roth also does not disclose “transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertise computer system.” The Examiner notes that Roth teaches the use of a “log unit.” The Examiner argues that Roth’s “log unit” communicates with advertisers and

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that Roth teaches a communication between the log unit and advertisers. The Examiner cites column 12, lines 12-40 and column 18, lines 21-27 in support of those assertions. Column 12, lines 12-40 of Roth read as follows:

During the normal operation of the system, the process begins upon receipt of a view-op from the browser 11. Upon receipt of a view-op the system does the following:

- 1) An attempt is made to identify the viewer via HTTP connect information. The system seeks to determine if this viewer has been seen before. This is done using conventional and well know HTTP protocol techniques, the data in data base 16B and conventional data base technology.
- 2) The data concerning the viewer is used to update the table's Current Viewer Data (table 410) relative to this view-op's viewer.
- 3) A view-op object (VOD 415) is transmitted to each bidding agent 30.
- 4) The bidding agents 30 determine if the view-op meets the requirements of various proposed bids.
- 5) Bids are collected from the bidding agents 30 and a determination is made as to the winning bid.
- 6) The winning bid includes an ad index identifying the ad to be displayed. This ad index which identifies an ad in table 16A is transmitted to the web server 310 and the appropriate ad is sent to the browser 11.
- 7) The tables 16B are updated as to the view-op just bought (as to all view-op data of the just sold item including Historic Viewer Data such as Site, Viewer, Time seeing this exposure, etc.).
- 8) Log and billing information is transmitted to a log and billing unit.

Column 18, lines 21-27 of Roth read as follows:

The log and billing unit 320A is a conventional data base program that provides conventional log and billing functions. As concerning users and web sites becomes old and stale, it is transmitted to an archive in log and billing unit 320A. A log of all transactions that takes place in the system is also maintained by unit 320A. This is done using conventional programming techniques.

Neither of these sections cited by the Examiner nor any other portion of Roth discloses that the log and billing unit in Roth communicates with advertisers; there is simply no discussion in Roth of any relationship between these entities (including communications between them). Even if Roth could be considered to disclose some type of communication between the log and billing unit and the advertisers, Roth certainly does not disclose that a correlation factor is transmitted as part of such communication. Thus, Roth does not disclose "transmitting said correlation factor to said advertiser computer system."

Furthermore, even if Roth could be read to teach that the log and billing unit somehow transmits a correlation factor to said advertiser computer system, Roth still

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does not disclose that the correlation factor is transmitted "prior to receiving a bid for said advertisement opportunity from said advertiser computer system." The log and billing information is just that - a log of the results of the bidding process. Therefore, the log and billing information cannot be created until after bids have been submitted. Since the information in the log and billing unit (i.e., a "correlation factor" according to the Examiner) is not created until after the bids are submitted then it clearly cannot be transmitted prior to receiving the bids. Since Roth does not disclose a "correlation factor," nor "transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertise computer system," Roth does not disclose all of the features of independent claim 1. Therefore independent claim 1 is believed to be allowable over Roth.

Independent claim 5 recites, transmitting a "correlation factor" to the advertiser "prior to receiving a bid for said advertisement opportunity from said plurality of computer systems representing advertisers." For the same reasons discussed in relation to claim 1, Roth does not disclose all of the features of independent claim 5. Therefore independent claim 5 is believed to be allowable over Roth.

Independent claim 52 recites a "correlation factor" and that "said successful bid is received in response to said correlation factor being transmitted for said advertisement opportunity..." Roth does not teach that the bid is received in response to the "correlation factor" being transmitted. Independent claim 63 recites that "said bid is based on said correlation factor." Roth does not teach that "said bid is based on said correlation factor." For these reasons and the same reasons as discussed in relation to claim 1, Roth does not disclose all of the features of independent claims 52 and 63. Therefore independent claims 52 and 63 are believed to be allowable over Roth.

Independent claim 59 recites a "correlation coefficient." Roth does not disclose a "correlation coefficient," only a Boolean analysis. For this reason and the same reasons as discussed in relation to claim 1, Roth does not disclose all of the features of independent claim 59. Therefore independent claim 59 is believed to be allowable over Roth.

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Independent claim 71 recites "receiving, at said advertiser computer system, from the profiler computer system, a correlation factor representing the correlation between said advertisement characterization and said consumer." For the same reasons as discussed in relation to claim 1, Roth does not disclose all of the features of independent claim 71. Therefore independent claim 71 is believed to be allowable over Roth.

With respect to independent claim 17, Applicant strenuously disagrees with the Examiner's characterization of "heuristic rules." Applicant maintains that Roth does not teach "heuristic rules." Notwithstanding, claim 17 has been canceled.

Dependent claims 9, 47-51, 53-58, 60-62, 64-70, and 72-80 are allowable at least by dependency on independent claim 1, 5, 52, 59, 63, and 71, respectively. Claims 10-11, 14, 17-19, 23, 25, 27-30, 32-34, 41-43 and 46 have been canceled, so therefore their rejection is moot. Reconsideration and withdrawal of the Examiner's anticipation rejection of claims 1, 5, 9-11, 14, 17-19, 23, 25, 27-30, 32-34, 41-43 and 46 are respectfully requested.

Prior Art Rejections – § 103(a)

The Examiner has rejected claims 2-4, 6-8, 12, 13, 15, 16, 26, 31, 35, 36, 39, and 44 under 35 U.S.C. § 103(a) as unpatentable over Roth in view of U.S. Patent No. 6,327,574 to Kramer ("Kramer").

As discussed above with respect to the Examiner's anticipation rejection over Roth, Roth does not disclose all of the elements of independent claims 1 and 5. Without admitting the propriety of the Examiner's combination of Kramer with Roth, Applicant respectfully submits that Kramer does not teach or suggest all of the elements of these independent claims that are missing from Roth. Accordingly, independent claims 1 and 5 are believed to be allowable over the combination of Roth and Kramer. Dependent claims 2-4 and 6-8 are allowable at least by their dependency on independent claims 1 and 5, respectively. Claims 12, 13, 15, 16, 26, 31, 35, 36, 39, and 44 have been canceled.

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Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 2-4, 6-8, 12, 13, 15, 16, 26, 31, 35, 36, 39, and 44 are respectfully requested.

The Examiner has rejected claims 20-22 as being unpatentable over Roth in view of U.S. Patent No. 5,835,896 to Fisher et al ("Fisher"). Without admitting the propriety of the Examiner's combination of Fisher with Roth, claims 20-22 have been canceled. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 20-22 are respectfully requested.

The Examiner has rejected claims 24, 37, 40, and 45 as being unpatentable over Roth in view of U.S. Patent No. 5,974,398 to Hanson et al. ("Hanson"). Without admitting the propriety of the Examiner's combination of Hanson with Roth, claims 24, 37, 40, and 45 have been canceled. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 24, 37, 40 and 45 are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-9 and 47-80, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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